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**UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION**

ASETEK DANMARK A/S,

**Plaintiff and
Counterdefendant,**

ASETEK USA, INC.,

Counterdefendant,

V.

COOLIT SYSTEMS, INC.,

Defendant and Counterclaimant,

COOLIT SYSTEMS USA INC., COOLIT SYSTEMS ASIA PACIFIC LIMITED, COOLIT SYSTEMS (SHENZHEN) CO., LTD.,

Defendants,

CORSAIR GAMING, INC. and CORSAIR MEMORY, INC.,

Defendants.

CASE NO. 3:19-cv-00410-EMC

**ASETEK DANMARK A/S AND ASETEK
USA, INC.'S NOTICE OF MOTION AND
MOTION FOR PARTIAL SUMMARY
JUDGMENT**

Date: May 5, 2022
Time: 1:30 PM
Location: Courtroom 5, 17th Floor
Judge: Hon. Edward M. Chen

NOTICE OF MOTION

TO ALL PARTIES AND THEIR RESPECTIVE COUNSEL OF RECORD:

PLEASE TAKE NOTICE THAT on May 5, 2022, at 1:30 PM in Courtroom 5, located on the 17th Floor of the above-entitled court at 450 Golden Gate Avenue, San Francisco, California, or a soon thereafter as the matter may be heard before Honorable Edward M. Chen, Plaintiff and Counterdefendant Asetek Danmark A/S and Counterdefendant Asetek USA, Inc. (collectively "Asetek") will and hereby does move for partial Summary Judgement under Fed. R. Civ. P. 56 and Civil Local Rule 56 and based upon this Notice of Motion, the accompanying Memorandum of Points and Authorities and all the authorities and evidence cited therein, the Declaration of Arpita Bhattacharyya, and the accompanying exhibits, all other papers and pleadings in this action, such additional arguments and evidence as may be presented to the Court at or before the hearing on this Motion, and any other matters of which this Court may take judicial notice.

As stated in the accompanying Memorandum, Asetek moves for partial summary judgment that:

1. The accused Asetek Generation 5, 6, and 7 products do not infringe CoolIT System, Inc.'s asserted U.S. Patent Nos. 8,746,330; 9,603,284; and 10,274,266. In the alternative, the asserted claims of these CoolIT patents are invalid for lack of written description.

2. Claims 17 and 19 of Asetek's U.S. Patent No. 8,240,362 are not invalid under the following obviousness combinations alleged by Defendant CoolIT Systems, Inc.: Ryu in view of Wu or Batchelder; Batchelder in view of Shin, Ryu, or Wu; and Yu in view of Wu.

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STATE OF RELIEF REQUESTED

Asetek respectfully requests that the Court grant partial summary judgment that:

1) The accused Asetek Generation 5, 6, and 7 products do not infringe CoolIT System, Inc.’s asserted U.S. Patent Nos. 8,746,330 (“the ’330 patent”); 9,603,284 (“the ’284 patent”); and 10,274,266 (“’266 patent”). In the alternative, the asserted claims of these CoolIT patents are invalid for lack of written description.

2) Claims 17 and 19 of Asetek's U.S. Patent No. 8,240,362 ("the '362 patent") are not invalid under the following obviousness combinations alleged by Defendant CoolIT Systems, Inc.: Ryu in view of Wu or Batchelder; Batchelder in view of Shin, Ryu, or Wu; and Yu in view of Wu.

MEMORANDUM OF POINTS AND AUTHORITIES

I. INTRODUCTION

Asetek moves for summary judgment on two issues. First, Asetek moves for summary judgment that Asetek's accused Generation 5, 6, and 7 products do not infringe CoolIT's asserted claims. As part of that motion, Asetek asks the Court to construe the claim term "plate" that is recited in each of CoolIT's assert claims in the '330, the '284, and the '266 patents. Under the proper construction of "plate," the accused products do not infringe. If, however, the Court disagrees with Asetek's construction of "plate," and gives "plate" a broad construction as proposed by CoolIT, then CoolIT's asserted claims should be found invalid for lack of written description.

Second, Asetek moves for summary judgment that claims 17 and 19 of Asetek's '362 patent are not invalid under certain asserted obviousness combinations because CoolIT failed to present evidence on motivation to combine and reasonable expectation of success in making those alleged combinations.

II. FACTUAL BACKGROUND

A. CoolIT's Infringement Allegations Against Asetek's Generation 5, 6, and 7 Products

CoolIT's '330 and '284 patents claim priority to U.S. provisional application No. 60/954,987 filed on August 9, 2007 ("the 2007 Provisional," Ex. D¹). CoolIT's '266 patent claims priority through a chain of continuations and a continuation-in-part application to the '330 patent, which in turn claims priority to the 2007 Provisional. Bhattacharyya Decl., ¶19. The '266 patent additionally claims priority to another provisional application No. 61/512,379 filed on July 27, 2011 ("the 2011 Provisional," Ex. E). *Id.* The 2011 Provisional included new subject matter disclosing compliant material that was not disclosed in the 2007 Provisional. Ex. E, Figs. 7, 11, and 12 (showing compliant surface 334), 21:13-23:12 (discussing "insert 334" that can be formed of a compliant material). Therefore, in an IPR filed by Asetek against the '266 patent (IPR2020-00825), Asetek argued that the 2007 Provisional did not provide any disclosure regarding the limitation "manifold body defin[ing] a pair of compliant surfaces" in independent claim 1 of the '266 patent, rather that disclosure was added in the 2011

¹ All exhibits are attached to the Declaration of Arpita Bhattacharyya ("Bhattacharyya Decl.")

1 Provisional. Bhattacharyya Decl., ¶20. Accordingly, Asetek argued that independent claim 1 of the
 2 '266 patent (and dependent claims 2, 4, 5, and 9) were not entitled to a priority date before July 27,
 3 2011 (i.e., the filing date of the 2011 Provisional). *Id.*

4 Specifically, Asetek argued that:

- 5 • The 2007 Provisional disclosed a rigid “plate” (i.e., plate 240) positioned over the
 6 microchannels and fins, which cannot be compared or equated to the “compliant surfaces”
 7 recited in the '266 patent. *Id.* at ¶21. Nowhere does the 2007 Provisional disclose that the
 8 “plate” is made of compliant material or has compliant surfaces. *Id.*
- 9 • The '266 patent (and the 2011 Provisional) specifically distinguish the “plate” from a
 10 compliant member/manifold (i.e., compliant insert 334) by stating that compliant surfaces
 11 367 of insert 334 can “reduce or eliminate the need for secondary machining operations
 12 used to make the respective distal ends of the fins generally coplanar and compatible with,
 13 for example, a rigid plate.” Ex. F, 15:31-63; Ex. E, 23:2-5 (directly contrasting compliant
 14 insert 334 with plate 240). Therefore, the 2007 Provisional’s disclosure regarding “plate”
 15 (i.e., plate 240) does not provide written description support for the “compliant surfaces”
 16 recited in the '266 patent claims. Bhattacharyya Decl., ¶21.

17 In response, CoolIT argued that the 2007 Provisional reasonably would have conveyed to a
 18 POSITA that “the inventor possessed a plate 240 made from a compliant material by August 9, 2007,”
 19 that the disclosure in the 2007 Provisional was “consistent with plate 240 being made from a compliant
 20 material,” and further that the “[a]dded disclosure in the 2011 Provisional and the '266 patent is
 21 consistent with plate 240 being made from a compliant material.” Ex. I at 21-28.

22 But the PTAB rejected each of CoolIT’s arguments attempting to show that plate 240 in the
 23 2007 Provisional was made of a compliant material, and instead agreed with Asetek that there was no
 24 written description support for “manifold body defin[ing] a pair of compliant surfaces” in the 2007
 25 Provisional. Ex. C at 23, 30. The PTAB specifically concluded the following:

- 26 • “We have reviewed the 2007 Provisional in its entirety, and nothing in the 2007 Provisional
 27 describes the material of which plate 240 is made, much less indicates that the inventor had

1 possession of an invention including a manifold body (i.e., plate 240) defining a pair of
 2 compliant surfaces.” *Id.* at 24.

- 3 • In discussing disclosure in the 2011 Provisional of the benefits of compliant insert 334 over
 4 plate 240, the PTAB stated: “**This is objective, intrinsic evidence that the inventor, as of**
 5 **2011, did not consider plate 240 to be made of what he described in the 2011 Provisional**
 6 **as being compliant material.**” *Id.* at 24-25 (emphasis added).
- 7 • “All references in the ’266 Patent to a ‘compliant body’ appear to derive from disclosures that
 8 were added in the 2011 Provisional.” *Id.* at 25.
- 9 • “**The inventor’s substitution of the phrase ‘rigid plate’ for the phrase ‘plate 240’ [in the**
 10 **’266 patent] is objective, intrinsic evidence that as of 2012, the inventor considered plate**
 11 **240 (which he was contrasting with compliant insert 334) to be made of a rigid, rather**
 12 **than compliant, material.**” *Id.* at 26 (emphasis added).
- 13 • CoolIT’s “arguments and the supporting testimony from Dr. Pokharna are weak on several
 14 levels and fall far short of demonstrating to a POSITA that the inventor had possession of a
 15 manifold body defin[ing] a pair of compliant surfaces in 2007.” *Id.* at 27.
- 16 • “**Nothing in the 2007 Provisional would have indicated to a POSITA that the inventor**
 17 **envisioned making plate 240 of a compliant material in order to perform a gasketing or**
 18 **sealing function.**” *Id.* at 28-29 (emphasis added).

19 Despite the PTAB’s above findings, and despite that CoolIT did not appeal the PTAB’s final
 20 decision or any of its findings (Bhattacharyya Decl., ¶22), CoolIT has implicitly construed the “plate”²
 21 (i.e., plate 240) recited in each asserted independent claim of the ’330, the ’284, and the ’266 patents
 22 to include manifold bodies made of compliant materials, and has mapped the claimed “plate” to a
 23 compliant gasket manifold in Asetek’s Gen 5, 6, and 7 products. Ex. A, 63:13-17 (CoolIT’s expert
 24 agreeing that “plate” is recited in each asserted claim); *see* Section IV.B, *infra* (discussing there is no
 25 genuine dispute that the “plate” is mapped to a compliant gasket in Asetek’s Gen 5, 6, and 7 products).

26
 27 ² Independent claim 1 of the ’330 patent recites “a plate positioned over the distal ends of the
 28 plurality of fins,” independent claim 12 recites “a plate positioned over the juxtaposed fins,” and
 independent claim 14 recites “an apertured plate overlying the microchannels.” Similarly,
 independent claims 1 and 15 of the ’284 patent recite a “plate positioned over the plurality of walls,”
 and independent claim 13 of the ’266 patent recites “a plate overlying the walls.”

1 **B. Alleged Obviousness of Asetek's '362 Patent Claims**

2 Asetek asserts claims 17 and 19 of the '362 patent against accused CoolIT products in this
 3 case. In alleging invalidity of these claims, CoolIT relies on the expert report of Dr. John Abraham.
 4 Dr. Abraham alleges that claims 17 and 19 of the '362 patent are obvious based on *nine* separate
 5 obviousness combinations: 1) Shin in view of Wu (Ground 1); 2) Shin in view of Batchelder (Ground
 6 2); 3) Shin in view of Laing (Ground 3); 4) Ryu in view of Wu (Ground 4); 5) Ryu in view of
 7 Batchelder (Ground 5); 6) Batchelder in view of Shin (Ground 6); 7) Batchelder in view of Ryu
 8 (Ground 7); 8) Batchelder in view of Wu (Ground 8); and 9) Yu in view of Wu (Ground 9). Ex. AA,
 9 20-21. Dr. Abraham did not assert anticipation of either claim. *Id.*

10 Asetek moves for summary judgment of no invalidity under Grounds 4-9. Asetek is not moving
 11 for summary judgment on the remaining three obviousness combinations (Ground 1-3) based on Shin
 12 in view of Wu, Batchelder, or Laing (although Asetek disputes the merits of those allegations).

13 **III. LEGAL STANDARD FOR SUMMARY JUDGMENT**

14 “Summary judgment is appropriate in a patent case, as in other cases, when there is no genuine
 15 issue as to any material fact and the moving party is entitled to judgment as a matter of law.” *Nike Inc.*
 16 *v. Wolverine World Wide, Inc.*, 43 F.3d 644, 646 (Fed. Cir. 1994); Fed. R. Civ. P. 56(a). “[T]here is
 17 no issue for trial unless there is sufficient evidence favoring the nonmoving party for a jury to return
 18 a verdict for that party. If the evidence [of the nonmovant] is merely colorable, or is not significantly
 19 probative, summary judgment may be granted.” *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 249-
 20 50 (1986) (internal citations omitted). If a claim or defense is factually unsupported, it should be
 21 disposed of on summary judgment. *Celotex Corp. v. Catrett*, 477 U.S. 317, 323-24 (1986). Moreover,
 22 the moving party need not “produce evidence showing the absence of a genuine issue of material fact”;
 23 instead, “the burden on the moving party may be discharged by ‘showing’—that is, pointing out to the
 24 district court—that there is an absence of evidence to support the nonmoving party’s case.” *Id.* at 325;
 25 *Massey v. Del Labs., Inc.*, 118 F.3d 1568, 1573 (Fed. Cir. 1997) (“[T]he patent itself carries a
 26 presumption of validity, which requires proof of facts supporting invalidity to rise to the level of clear
 27 and convincing evidence. Therefore, to prevail on her motion for summary judgment of validity, [the
 28 patentee] need not have presented any factual evidence.”) (internal citation omitted).

1 “To establish infringement, every limitation set forth in a patent claim must be found in an
 2 accused product or process exactly or by a substantial equivalent.” *Laitram Corp. v. Rexnord, Inc.*,
 3 939 F.2d 1533, 1535 (Fed. Cir. 1991) (citing *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868
 4 F.2d 1251, 1259 (Fed. Cir. 1989). Summary judgment of noninfringement is appropriate where there
 5 is no genuine issue of material fact that the accused product does not include one or more limitations
 6 of the asserted patent claim either literally or under the doctrine of equivalents. *Nike*, 43 F.3d at 647
 7 (rejecting Nike’s proposed claim construction and affirming the district court’s grant of summary
 8 judgment of non-infringement because “no reasonable jury could have found that Wolverine’s shoes
 9 literally infringed any claim of the [Nike] patent” under the proper claim construction); *Carnegie*
 10 *Mellon Univ. v. Hoffmann-LaRoche, Inc.*, 55 F. Supp. 2d 1024, 1043-45, 1047-48 (N.D. Cal. 1999)
 11 (granting summary judgment of no infringement because the accused products did not include every
 12 limitation of the asserted claims literally or by an equivalent).

13 “The burden of establishing invalidity of a patent or any claim thereof rests on the party
 14 asserting such invalidity.” 35 U.S.C. § 282(a). For summary judgment of no invalidity, the patentee
 15 must show that “the nonmoving party, who bears the burden of proof at trial, failed to produce clear
 16 and convincing evidence on an essential element of a defense upon which a reasonable jury could
 17 invalidate the patent.” *Eli Lilly and Co. v. Barr Labs., Inc.*, 251 F.3d 955, 962 (Fed. Cir. 2001).
 18 Summary judgment of non-obviousness is appropriate where the party challenging patent validity fails
 19 to show the existence of clear and convincing evidence supporting the factual bases of the legal
 20 conclusion of obviousness. *See, e.g., Eisai Co. v. Dr. Reddy’s Labs., Ltd.*, 533 F.3d 1353, 1356, 1358-
 21 59 (Fed. Cir. 2008) (affirming district court’s grant of summary judgment of non-obviousness for
 22 failure to provide any reason why a skilled artisan would have modified a known compound to arrive
 23 at the claimed invention); *Mytee Products, Inc. v. Harris Research, Inc.*, 439 Fed. Appx. 882, 886
 24 (Fed. Cir. 2011) (affirming district court’s grant of summary judgment of non-obviousness for failing
 25 to “provide any reason why a person of ordinary skill would have been motivated to combine the
 26 references”).

1 **IV. THE COURT SHOULD GRANT SUMMARY JUDGMENT THAT ASETEK'S
2 GENERATION 5, 6, AND 7 PRODUCTS DO NOT INFRINGE COOLIT'S
3 ASSERTED CLAIMS BECAUSE THERE IS NO GENUINE DISPUTE THAT
4 THE PRODUCTS DO NOT INCLUDE THE CLAIMED "PLATE" AS
5 PROPERLY CONSTRUED**

6 There is no genuine dispute that the alleged "plate" in Asetek's Gen 5, 6, and 7 products is
7 made of a compliant material, namely EPDM rubber. Instead, the dispute between the parties is a legal
8 question of claim scope: whether the claimed "plate" can be construed broadly to include manifold
9 bodies made of any material — rigid (e.g., metal) or compliant (e.g., EPDM rubber). Based on the
10 intrinsic record of the asserted CoolIT patents and the PTAB's final judgment in an IPR on a related
11 patent (*see* Section II.A, *supra*), the claimed "plate" should be construed as a manifold body made of
12 a rigid material. And under this proper construction, there can be no genuine dispute of material fact
13 that Asetek's Gen 5, 6, and 7 products do not infringe CoolIT's asserted claims because the alleged
14 "plate" in these products is made of a compliant material (and not a rigid material).

15 This rigid vs. compliant characteristic of the recited "plate" is relevant to claim construction
16 because, as the PTAB has already found, there is no written description for a compliant "plate" or
17 manifold body in CoolIT's 2007 Provisional (to which all the asserted claims claim priority); the 2007
18 Provisional disclosed only a rigid "plate." Indeed, four years later in the 2011 Provisional, CoolIT
19 separately disclosed manifold bodies made of compliant materials, explicitly contrasted the rigid plate
20 240 disclosed in the 2007 Provisional with the compliant manifold bodies first disclosed in the 2011
21 Provisional, and touted the benefits of compliant over rigid materials. During prosecution of CoolIT's
22 later patents as well, CoolIT explicitly distinguished a prior-art rigid plate from the compliant member
23 (manifold) recited in its later patents, and CoolIT gained allowance of those later patent claims based
24 on that rigid vs. compliant distinction.

25 But now in this case, in which CoolIT is asserting its older patents that claim priority to the
26 2007 Provisional and disclose only a rigid "plate," CoolIT is improperly attempting to construe the
27 claimed "plate" more broadly, and beyond the written description, to include manifold bodies made
28 of compliant materials. In so doing, CoolIT is trying to improperly capture its later-disclosed
compliant material subject matter into the scope of its earlier-filed patent claims in an effort to prove
infringement against Asetek, which is impermissible. *See PowerOasis, Inc. v. T-Mobile USA, Inc.*,

1 522 F.3d 1299, 1309-11 (Fed. Cir. 2008) (discussed in detail below). Significantly, because the PTAB
 2 has already ruled in a final judgment that the 2007 Provisional does not provide written description
 3 support for a “plate” made of compliant material, CoolIT cannot dispute the PTAB’s ruling and is
 4 collaterally estopped from relitigating the same written description issue in this case. Nor can CoolIT
 5 legitimately dispute its statements to the Patent Office distinguishing a rigid “plate” from a compliant
 6 manifold to obtain allowance of later patents.

7 Nevertheless, if the Court finds that “plate” could be construed broadly to include manifold
 8 bodies made of any material (rigid or compliant), which Asetek respectfully submits the Court should
 9 not, then the Court should grant Asetek summary judgment of invalidity of the CoolIT patents under
 10 Section 112, ¶1 because, as the PTAB already found in a final judgment, the 2007 Provisional does
 11 not provide written description support for the full scope of “plate” as construed, including compliant
 12 manifold bodies.

13 **A. The Court should construe “plate” as a “flat manifold body made of a rigid
 material”**

14 The parties’ experts agree that a “plate” in the context of CoolIT’s claimed invention is flat
 15 and is positioned over the microchannels and fins. Ex. A, 92:1-13, 94:14-22 (CoolIT’s expert agreeing
 16 that the “plate” is “flat” or “substantially flat” and “cover[s] the top of the channels”); Ex. B, ¶42.
 17 CoolIT’s expert, however, has argued that “plate” can include manifolds of any material, e.g., “metal,”
 18 “EPDM,” “silicone” or “Styrofoam” as long as the “plate” “perform[s] a job of covering the top of the
 19 channels.” Ex. A, 92:1-95:7. In contrast, Asetek’s expert has argued that the “plate” is made of a rigid
 20 material, e.g., metal. Ex. B, ¶42. Thus, the only dispute between the parties and their experts is whether
 21 the “plate” is limited to rigid material (Asetek’s position), or whether “plate” can include manifold
 22 bodies made of compliant material (CoolIT’s position). For the reasons explained below, CoolIT and
 23 its expert’s implicit construction of “plate,” and their application of that construction to Asetek’s Gen
 24 5, 6, and 7 products, are incorrect. “Plate” should properly be construed as a “flat manifold body made
 25 of a rigid material.” Ex. B, ¶42.

26 **1. “Plate” has no established plain and ordinary meaning, and
 therefore must be construed based on the intrinsic record**

27 The claim term “plate” was not previously construed, and might have been accorded a plain
 28 and ordinary meaning, but as this case has progressed through fact and expert discovery, and after the

1 *Markman* hearings and parallel IPR proceedings, it has become clear that claim construction of “plate”
 2 will be necessary to resolve the parties’ disputes over alleged infringement and validity for both trial
 3 and summary judgment proceedings. If this claim construction dispute is not resolved by the Court
 4 prior to trial, it will likely create jury confusion regarding the scope of CoolIT’s asserted claims, and
 5 force the jury to decide the issue of the claim scope, which would be legal error. *Eon Corp. IP Holdings*
 6 v. *Silver Spring Networks Inc.*, 815 F.3d 1314, 1319 (Fed. Cir. 2016) (finding that leaving the question
 7 of claim scope to the jury is legal error). It is also necessary to resolve this claim construction dispute
 8 regarding “plate” to resolve pending summary judgment issues, including non-infringement and
 9 written description, because the first step of those analyses is to determine the scope and specificity of
 10 the claims. *O2 Micro Int’l Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351, 1361 (Fed. Cir. 2008)
 11 (“[When] the ‘ordinary’ meaning of a term does not resolve the parties’ dispute, . . . [then] claim
 12 construction requires the court to determine what claim scope is appropriate in the context of the
 13 patents-in-suit”).

14 Here, the principal reason for the parties’ claim construction dispute is that the claim term
 15 “plate” does not have a single, established plain and ordinary meaning that can be harmonized with
 16 the patent disclosures. *Lexion Med., LLC v. Northgate Techs., Inc.*, 641 F.3d 1352, 1356 (Fed. Cir.
 17 2011) (“The customary meaning of a claim term is not determined in a vacuum and should be
 18 harmonized, to the extent possible, with the intrinsic record, as understood within the technological
 19 field of the invention.”). Asetek’s expert has opined that a person skilled in the art would not consider
 20 a compliant object, such as a gasket, to be a “plate.” Ex. B, ¶¶42, 43. In contrast, CoolIT’s expert has
 21 opined that the ordinary meaning of “plate” would include structures made of any material, rigid or
 22 compliant, as long as the “plate” is “perform[ing] a job of covering the top of the channels.” Ex. A,
 23 92:1-93:14, 94:14-95:7. The parties’ experts’ disagreement on the meaning of “plate,” and the failure
 24 of the claims themselves to provide a single, well-understood meaning, shows that “plate” is a
 25 technical term that does not have a plain and ordinary meaning in the field of computer liquid cooling
 26 and/or CoolIT’s patents. That is why the Court should construe “plate” in the context of CoolIT’s
 27 patents’ written description and prosecution history. See *Kaneka Corp. v. Xiamen Kingdomway Grp.*
 28 *Co.*, 790 F.3d 1298, 1305 (Fed. Cir. 2015) (finding that because the term “sealed” may have more than

1 one plain and ordinary meaning, the appropriate definition needed to be ascertained from the intrinsic
 2 evidence); *Goldenberg v. Cytogen, Inc.*, 373 F.3d 1158, 1164 (Fed. Cir. 2004) (“Where a claim term
 3 has no ordinary and customary meaning, a court must resort to the remaining intrinsic evidence—the
 4 written description and the prosecution history—to obtain the meaning of that term.”).

5 So not only is claim construction of “plate” necessary under *Eon Corp.* and other Federal
 6 Circuit precedent, it is necessary to resolve the experts’ conflicting interpretations of “plate” in view
 7 of the intrinsic record for summary judgment and to avoid jury confusion from conflicting expert
 8 testimony at trial.

9 **2. Asetek’s construction of “plate” is consistent with the intrinsic
 10 record; CoolIT’s purported construction is not**

11 **a. Asetek’s construction of “plate” as a rigid manifold body is
 12 supported by the written description and the PTAB’s judgment**

13 As Asetek’s expert has explained, a person skilled in the art would understand from the
 14 intrinsic record of the CoolIT patents that the claimed “plate” is made of rigid material, e.g., metal.
 15 Ex. B, ¶42. Asetek’s expert further explained that a person skilled in the art “would not likely refer to
 16 a compliant object,” such as the compliant gasket in Asetek’s Gen 5, 6, and 7 products, “as a ‘plate,’”
 17 rather it would have been likely referred to as a gasket, elastomer, flexible seal, compliant member,
 18 compliant body, etc. (but not a plate).” *Id.* The PTAB agreed with Asetek’s expert and found, contrary
 19 to CoolIT and its expert’s argument, that there is no written description support in the 2007 Provisional
 20 for the “plate” being made of a “complaint material”; rather, the PTAB ruled that at the time of the
 21 alleged invention in 2007, the inventor considered the claimed “plate” to be made of rigid material.
 22 Ex. C at 25, 26; *see also* Section II.A, *supra*. Given that the scope of the claim cannot exceed the
 23 inventor’s disclosure in the specification, Asetek’s proposed construction of “plate” as made of a rigid
 24 material is correct. *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1480 (Fed. Cir. 1998)
 25 (holding that a claim “may be no broader than the supporting disclosure, and therefore [] a narrow
 26 disclosure will limit claim breadth”); *On Demand Mach. Corp. v. Ingram Indus.*, 442 F.3d 1331, 1340
 27 (Fed. Cir. 2006) (“[T]he role of the specification is to describe and enable the invention. In turn, the
 28 claims cannot be of broader scope than the invention that is set forth in the specification.”); *Ruckus
 Wireless, Inc. v. Innovative Wireless Sols., LLC*, 824 F.3d 999, 1010 (Fed. Cir. 2016) (“Because the

specification makes no mention of wireless communications, construing the instant claims to encompass that subject matter would likely render the claims invalid for lack of written description” (citing *Gentry Gallery*); *Intellectual Ventures I v. Motorola Mobility LLC*, 870 F.3d 1320, 1326-27 (Fed. Cir. 2017) (finding claim terms “should be construed to exclude long-term or permanent storage” because they are not within “the scope of the invention,” and that “the proper result is not that [the claim] fails for lack of written description but that it should be construed ‘in view of the specification’ to be limited.”) (citation omitted).

The *Intellectual Ventures I* case is particularly instructive here. There, defendant Motorola argued that the claim should be interpreted broadly to include “long-term or permanent storage” because the plain language of the claim “neither plainly includes nor plainly excludes long-term or permanent storage.” 870 F.3d at 1325-26. But, because the patent specification “exclude[s] long-term or permanent storage from the scope of the invention,” Motorola argued that the claim should instead be found invalid for lack of written description. *Id.* at 1324-25. Both the district court and the Federal Circuit agreed with Motorola that long-term or permanent storage was outside the written description, but instead of finding the claim invalid for lack of written description, both courts concluded that the claim limitation “must be construed in view of the specification” to “exclude long-term or permanent storage” from the claim scope. *Id.* at 1326 (internal citation and quotation omitted). Here, just as in *Intellectual Ventures I*, CoolIT seems to be asserting that the claim term “plate” should be construed broadly to include manifold bodies made of any material (including both rigid and compliant materials) because the plain language of the claims does not limit the material of the “plate.” *See, e.g.*, Ex. A, 95:4-7. But as the PTAB has found, there is no written description for “plate” made of compliant material. Therefore, following the Federal Circuit’s guidance in *Intellectual Ventures I*, the correct result would be to construe “plate” in view of the written description to exclude manifold bodies made of compliant materials (instead of finding CoolIT’s asserted claims invalid for lack of written description). 870 F.3d at 1326-27; *see also Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1365 (Fed. Cir. 2010) (Rader, J., concurring in part) (explaining that if claims are properly construed to “not enlarge what the inventor has described, then the claims would never have a scope that exceeds the disclosure in the rest of the specification” and that it be would be error to construe claims broadly and

1 then find them invalid for lack of written description). Accordingly, Asetek's proposed construction
 2 of "plate" as a "flat manifold body made of rigid material" is correct in view of the written description
 3 and should thus be adopted. And if not, then the claims should be found invalid, as explained below.

4 **b. The written description and prosecution history of the CoolIT's
 5 patents contradict CoolIT's proposed construction, which
 6 attempts to erase all distinctions between a rigid "plate" and a
 7 compliant manifold**

8 In contrast to Asetek's construction, CoolIT's construction is impermissibly broad and
 9 incorrect for four separate reasons: 1) there is no written description support for CoolIT's proposed
 10 construction of "plate"; 2) it would improperly exclude the plate material (and whether it is rigid or
 11 compliant) even though the material (property) is a defining characteristic of the claimed "plate," 3) it
 12 would allow CoolIT to capture subject matter not disclosed until nearly almost *four years after* the
 13 effective filing date/priority date of the asserted claims, which is impermissible; and 4) CoolIT
 14 expressly distinguished a rigid "plate" from a compliant manifold member during prosecution of its
 15 later U.S. Patent No. 9,057,567 ("the '567 patent)³ that claims priority to the 2011 Provisional.

16 First, CoolIT's proposed construction would include manifold bodies made of any material,
 17 including compliant material, within the scope of the recited "plate," even though the PTAB expressly
 18 found that there is no written description support for a "plate" made of compliant material, as explained
 19 in Section IV.C, *infra*. CoolIT's proposed construction should be rejected for that reason alone. *Gentry*
Gallery, 134 F.3d at 1480; *On Demand Mach. Corp.*, 442 F.3d at 1340; *Ruckus Wireless*, 824 F.3d at
 20 1010; *Intellectual Ventures I*, 870 F.3d at 1326-27.

21 Second, CoolIT's construction disregards the material property of the "plate," which is a
 22 defining characteristic of the manifold body disclosed in the specification. The rigid vs. compliant
 23 property of the "plate" is an important feature that CoolIT itself contrasts in its later patent disclosures.
 24 Specifically, CoolIT's 2011 Provisional, which introduced a compliant manifold body (i.e., compliant
 25 insert 334) for the first time, disclosed the following:

26 In a working embodiment, the [manifold] body 360 is formed of a compliant
 27 polymeric material that generally conforms to and seals against adjacent surfaces.
 28 Ex. E, 23:8-9.

³ The '567 patent was in the same family as CoolIT's '266 still asserted against Asetek. After the PTAB found all of CoolIT's asserted claims in the '567 patent unpatentable in an IPR filed by Asetek on that patent, the '567 patent is no longer at issue in this case.

1 Several pages later, the 2011 Provisional described the benefits of compliant insert 334 over
 2 the plate 240 disclosed in the 2007 Provisional:

3 By incorporating the compliant insert 334, secondary machining
 4 operations that would tend to dull the sharp pieces 405 can be
 5 eliminated to reduce heat losses in the coolant, while still reducing or
 6 eliminating leakage between adjacent microchannels that might
 otherwise occur from using “raw” fins due to gaps that would be
 formed between the fins and, e.g., a generally planar plate 240.

7 *Id.* at 26:13-17.

8 CoolIT further explained in the 2011 Provisional that the conformable surfaces 367 of
 9 compliant insert 334 can “conform[] to variations in height among the plurality of fins,” and thereby
 10 “can reduce or eliminate the need for secondary machining operations used to make the respective
 11 distal ends of the fins generally coplanar and compatible with, for example, the plate 240.” *Id.* at
 12 22:26-23:5 (emphasis added). Indeed, the PTAB, upon reading the above disclosures in the 2011
 13 Provisional, which contrast and tout the benefits of compliant insert 334 over plate 240, concluded
 14 that “[t]his is objective, intrinsic evidence that the inventor, as of 2011, did not consider plate 240
 15 to be made of what he described in the 2011 Provisional as being compliant material.” Ex. C at
 16 24-25 (emphasis added).

17 In CoolIT’s issued ’266 patent, which claims priority to the 2011 Provisional, CoolIT again
 18 distinguished the earlier-disclosed rigid plate 240 from the new compliant insert 334. The language in
 19 the ’266 patent is nearly identical to that in the 2011 Provisional except that it explicitly described the
 20 plate over the microchannels as “rigid” by substituting the phrase “rigid plate” for the phrase “plate
 21 240,” as shown by the relevant language underlined in the passages below:

22 “The conformable surfaces 367 can reduce or eliminate the need for
 23 secondary machining operations used to make the respective distal ends of the
 24 fins generally coplanar and compatible with, for example, the a rigid plate
240.”

25 Compare Ex. F [’266 patent], 15:60-63 (referring to “rigid plate”) with Ex. E [2011 Provisional],
 26 23:2-5 (referring to “plate 240”) (interlineation added to show change).

27 Based on these distinctions and changes by the applicant, the PTAB found that “[t]he
 28 inventor’s substitution of the phrase ‘rigid plate’ for the phrase ‘plate 240,’ is objective, intrinsic

1 evidence that as of 2012 [when the '266 patent application was filed], the inventor considered
 2 plate 240 (which he was contrasting with compliant insert 334) to me made of a rigid, rather
 3 than compliant, material.” Ex. C at 25-26 (emphasis added).

4 As discussed above, and as the PTAB found, CoolIT itself distinguishes a rigid “plate”
 5 disclosed in the 2007 Provisional from a compliant manifold body disclosed for the first time in the
 6 2011 Provisional. Accordingly, CoolIT cannot now argue that the rigid vs. compliant material
 7 characteristic is unimportant in distinguishing the claimed “plate” from the later-disclosed compliant
 8 manifold body, or that “plate” should be construed so broadly that it covers both a rigid plate (as in
 9 Asetek’s Gen 4 products) as well as a compliant manifold body (as in Asetek’s Gen 5, 6, and 7
 10 products). Although CoolIT remained silent on the material of the “plate” in its construction, its
 11 technical expert has opined that the plate can be made of any material (rigid or compliant), which
 12 CoolIT obviously intends to argue in this case and to the jury. This is improper for the many reasons
 13 discussed in this motion and should be corrected by adopting Asetek’s construction of “plate.”

14 Third, CoolIT’s construction would also allow it to improperly capture later-disclosed subject
 15 matter within the scope of the claims for purposes of infringement, while continuing to claim the
 16 benefit of the 2007 priority date for purposes of validity. More specifically, CoolIT contends that the
 17 earliest priority date of the asserted claims is August 2007, thus avoiding prior art disclosures between
 18 August 2007 and July 2011. Ex. A, 52:15-53:5 (CoolIT’s expert agreeing he applied the 2007 priority
 19 date for claims 13 and 15 of the '266 patent); Dkt. 23-1 at PDF p. 2 and 23-2 at PDF pp. 2, 3 (cover
 20 pages showing the '330 and the '284 patents claim earliest priority date of August 2007). But at the
 21 same time, in an attempt to prove infringement by Asetek’s Gen 5, 6, and 7 products, CoolIT contends
 22 that “plate” should be interpreted broadly to include manifold bodies made of any material, rigid or
 23 compliant, even though the disclosure about compliant manifold bodies was not added until July 2011.
 24 CoolIT cannot have it both ways: it may not assert a broad claim construction for purposes of
 25 infringement and a narrower construction for purposes of validity. *Amazon.com, Inc. v.*
Barnesandnoble.com, Inc., 239 F.3d 1343, 1351 (Fed. Cir. 2001) (“[T]he claims must be interpreted
 26 and given the same meaning for purposes of both validity and infringement analyses.”).

28

1 In *PowerOasis*, the Federal Circuit rejected an argument similar to CoolIT’s here. 522 F.3d at
 2 1309-11. There, patentee PowerOasis argued for and received a broad construction of the claim term
 3 “customer interface” even though the priority patent application (i.e., the first application in the patent
 4 chain to which PowerOasis claimed priority) did not provide written description support for the
 5 breadth of PowerOasis’s construction; instead, support for the broad construction came only from
 6 material added to a later-filed continuation-in-part (CIP) application. *Id.* As a result, the district court
 7 correctly found that the broadly-construed claims urged by PowerOasis were not entitled to an
 8 effective filing date of the earlier-filed priority application, but were instead accorded the effective
 9 filing date of the later-filed CIP application. *Id.* at 1302-03. Based on that finding, the trial court then
 10 correctly entered summary judgment of invalidity based on prior art dated after the priority application
 11 but before the CIP application. *Id.* at 1302-03. The Federal Circuit affirmed (*id.* at 1307, 1311) and
 12 rejected PowerOasis’s arguments that it was entitled to the effective filing date of the priority
 13 application because it supported a narrower construction of the disputed term (even though the broader
 14 construction was not fully supported by the priority application). *See id.* (explaining that to get the
 15 benefit of the priority application date, the priority application had to support “the broader construction
 16 of a ‘customer interface’” that was granted by the district court). Similarly, here the 2007 Provisional
 17 may support a narrower construction of “plate” as a rigid manifold body, but it indisputably cannot
 18 support the broader construction of a “plate” as a manifold body made of any material (rigid or
 19 compliant), which CoolIT needs to prove infringement by Asetek’s Gen 5, 6, and 7 products. Allowing
 20 CoolIT to claim the effective filing date of the 2007 Provisional (and thus avoid prior art between
 21 2007 and 2011), and at the same time giving “plate” a broad construction that is not supported by the
 22 2007 Provisional, would violate the Federal Circuit’s precedent in *PowerOasis* and black letter patent
 23 law that claims must be construed the same for purposes of infringement and validity.

24 Fourth, during prosecution of CoolIT’s ’567 patent, CoolIT distinguished prior art asserted by
 25 the examiner by contrasting rigid plates in the prior art from the compliant member (manifold)
 26 disclosed in CoolIT’s ’567 patent application. Specifically, CoolIT made the following statement:

27 Nelson’s plate 36 is not equivalent to a claimed compliant member.
 28 **Nelson’s plate 36 is also understood to be stiff and rigid**, in part
 because Nelson refers to it as a “plate” rather than another term

1 connoting flexibility, conformability, or compliance, such as, for
 2 example, “gasket” or “seal.”
 3

4 Ex. J at PDF p. 27.
 5

6 Thus, CoolIT not only distinguished “plate” from a compliant member, CoolIT also asserted
 7 to the Patent Office that the term “plate” itself connotes lack of compliance, whereas terms like
 8 “gasket” or “seal” connote compliance. *See id.* (N.B. This point by CoolIT’s prosecution attorney is
 9 exactly the point made by Asetek’s technical expert (Ex. B, ¶42), and which CoolIT’s expert now tries
 10 to dispute in an attempt to assert the ’266 patent against Asetek’s products that have compliant gaskets
 11 instead of plates (Ex. A, 92:1-94:22)). Following these arguments made by CoolIT, the examiner
 12 allowed the ’567 patent claims, relying largely on CoolIT’s distinction between the prior-art “plate”
 13 and the claimed compliant manifold:
 14

15 The closest prior art of record Nelson US Patent No.: 4,909,315
 16 discloses a heat sink with fins that have a groove and a cover above the
 17 fins, **but not a cover that is a compliant member** that has an opening
 18 positioned over every fin and distribute fluid transverse to the fins and
 19 then parallel to the fins as claimed. Although it is well known to
 20 provide a heat sink within a housing for a pump, **there is no teaching**
in the prior art of record that would, reasonably and absent
impermissible hindsight, motivate one having ordinary skill in the art
to modify the teachings of the prior art to incorporate a compliant
member aligned above a heat sink with grooves to distribute fluid in
the manner as claimed. Thus, for at least the foregoing reasons, the
 21 prior art of record neither anticipates nor rendered obvious the present
 22 invention as set forth in claims 49 and 80.
 23

24 Ex. J at PDF pp. 11-12 (emphasis added).
 25

26 Similarly, during prosecution of the ’266 patent, which also claims priority to the 2011
 27 Provisional, CoolIT again asserted the significance of the compliant manifold over the prior art by
 28 telling the Patent Office that the prior art is “silent regarding, and does not appreciate the desirability
 29 of providing, a pair of compliant surfaces urging against the fins.” Ex. K, PDF p. 6. CoolIT should not
 30 be permitted to now walk back the distinctions it made between a rigid (non-compliant) “plate”
 31 (disclosed in 2007) and compliant manifold (disclosed in 2011) to gain allowance of its patent claims.
 32 Rather, CoolIT’s statements to the Patent Office should bind CoolIT to a claim construction of “plate”
 33 that does not include the later-disclosed compliant manifold.
 34

35 In sum, CoolIT’s broad interpretation of “plate” as a manifold body made of any material (rigid
 36 or compliant) is not supported by the written description of the 2007 Provisional, and therefore
 37

1 CoolIT's construction cannot be correct. Moreover, CoolIT expressly distinguished a rigid "plate"
 2 from a compliant manifold during prosecution of its patents, so its present (incorrect) position that
 3 "plate" should be construed broadly to include both rigid and compliant materials is improper.
 4 Asetek's construction of "plate" as a manifold body made of rigid material is the only construction
 5 that is supported by, and consistent with, the 2007 Provisional disclosure and CoolIT's prosecution
 6 history. Therefore, Asetek's construction is the correct construction and should be adopted.

7 **B. Under the proper construction of "plate" as a manifold body made of rigid**
 8 **material, there is no genuine dispute that Asetek's Gen 5, 6, and 7 products do**
 not infringe the asserted claims

9 CoolIT's expert, Dr. Himanshu Pokharna, agrees that in his infringement opinion(s) he has
 10 mapped the claimed "plate" to a compliant gasket that overlies the microchannels and fins in Asetek's
 11 accused Generation 5, 6, and 7 products:

12 Q. I'm not talking about the heat spreader
 13 plate. I'm talking about the gasket that overlies the
 microchannels and fins of the heat spreader plate.
 14 That gasket, and especially the portion of the gasket
 that overlies the microchannel and microchannel fins,
 is made of a compliant material; right?
 15 ...

16 A. Yeah. **So that portion of**
 17 **gasket that overlies the microchannel is what I'm**
 referring to as the plate. And I'm -- I'm agreeing
 that that entire assembly is made out of the same
 material.
 18 ...

19 Q. **And that same material is the compliant**
 material; correct?
 20 ...

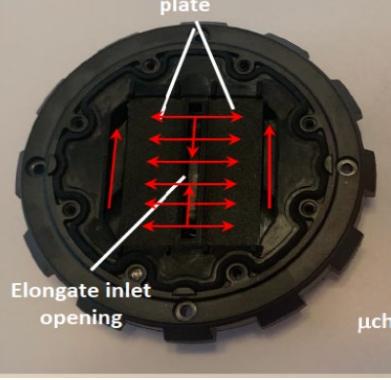
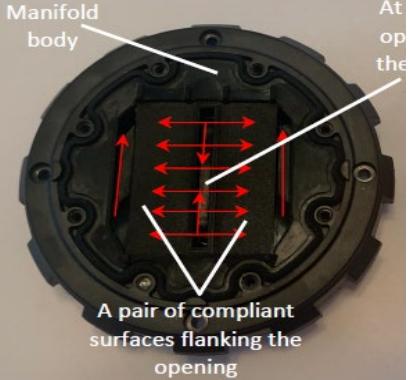
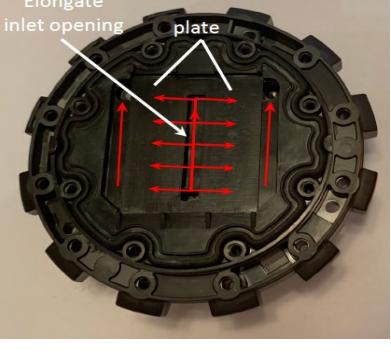
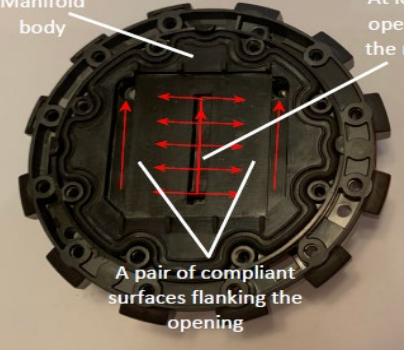
21 A. **Because it has to perform the**
 22 **seal operation, where the compliance is really**
 important, it is -- the entire part is made out of
 what you would call a compliant material.

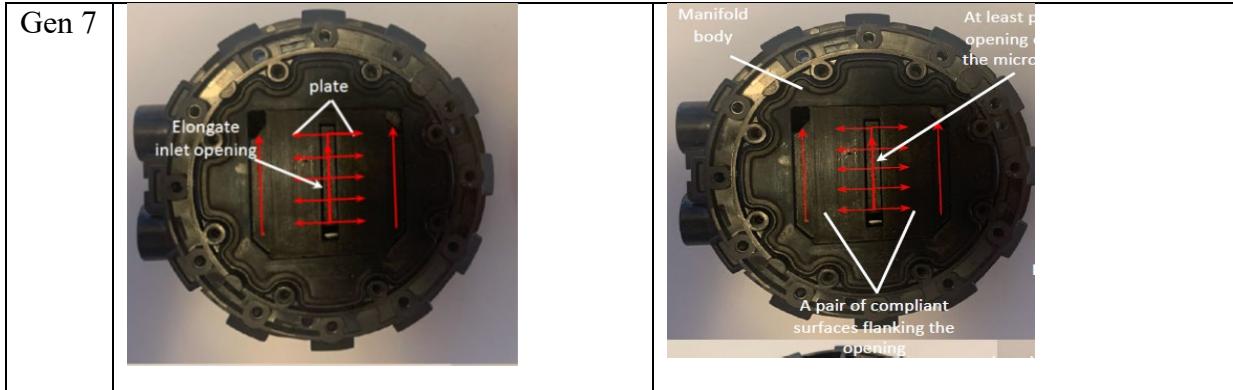
23 Ex. A, 80:21-81:17. (emphases added); *see also id.* at 91:12-24 (Q. "With respect to Asetek's accused
 24 Gen 5, 6, and 7 products, you are referring to the portion of the gasket structure that overlies the
 25 microchannels -- microchannels and microchannel fins of the heat spreader plate as the claimed plate;
 26 correct? A. **That's correct.** Q. In Asetek's accused Gen 5, 6, and 7 products, the portion of the gasket
 27 structure that overlies the microchannels and microchannel fins of the heat spreader plate is made of
 28 EPDM; correct? ... A. **Yes, it's made of EPDM.**") and 77:2-17 (Q. "And EPDM is a compliant

1 material; correct?" A. "EPDM is a soft material, yes."); *see also id.* at 66:3-12, 67:17-69:6, 79:16-
 2 80:9, 81:22-82:23, 85:20-86:10 (CoolIT's expert agreeing that the portion of the Asetek products
 3 mapped to the claimed "plate" is made of compliant material).

4 Scientific articles and published U.S. patents also indisputably demonstrate that rubber,
 5 including EPDM rubber, which constitutes the gasket (the alleged "plate") in Asetek's Gen 5, 6, and
 6 7 products, is a compliant material. *See Ex. L* [U.S. Patent No. 9,130,198], 62:6-9 (identifying EPDM
 7 rubber as a compliant material); *Ex. M* [U.S. Patent No. 9,308,490], 2:38-40, 25:33-35 (same); *Ex. N*
 8 [U.S. Patent No. 9,631,759], 5:9-11, 10:46-48 (same); *Ex. O* [U.S. Patent No. 10,543,637], 10:26-37
 9 (same); *Ex. P* [Ashby] at 29, 34 (discussing low modulus materials as floppy, i.e., compliant, and
 10 providing rubber as an example of such floppy material).

11 CoolIT's expert's annotated images of the gaskets in Asetek's Gen 5, 6, and 7 products, as
 12 shown below, further demonstrate that CoolIT agrees the gaskets (which CoolIT asserts are the
 13 claimed "plate") is made of a compliant material:

	CoolIT's expert's annotations of the gaskets in Asetek's Gen 5, 6, 7 products as the alleged "plate"	CoolIT's expert's annotations of the same alleged "plate" as having compliant surfaces
Gen 5	 <p>plate</p> <p>Elongate inlet opening</p> <p>μch</p>	 <p>Manifold body</p> <p>A pair of compliant surfaces flanking the opening</p>
Gen 6	 <p>Elongate inlet opening</p> <p>plate</p>	 <p>Manifold body</p> <p>A pair of compliant surfaces flanking the opening</p>



7 Ex. G at 29, 51, 74 (images on the left); Ex. H at 19, 41, 64 (images on the right).

8 Asetek's expert, Dr. Tuckerman, also agrees that CoolIT's expert mapped the claimed "plate" 9 to a gasket made of a compliant material in the accused Asetek Gen 5, 6, and 7 products. Ex. B, ¶42 10 ("CoolIT maps the compliant rubber gasket positioned over the fins and microchannels to the claimed 11 'plate.'"); ¶¶43, 59-61, 66-68. Thus, there is no factual dispute that for each of Asetek's accused 12 Generation 5, 6, and 7 products, CoolIT has mapped the claimed "plate" to a gasket made of compliant 13 material (specifically, EPDM which is a form of synthetic rubber). Accordingly, if "plate" is construed 14 correctly to mean a manifold body made of a rigid material, then there can be no genuine dispute that 15 Asetek's Gen 5, 6, and 7 products do not include the claimed "plate" and thus do not infringe the 16 asserted claims. Summary judgment of no infringement of CoolIT's asserted claims by Asetek's Gen 17 5, 6, and 7 products should therefore be granted. *Nike*, 43 F.3d at 647.

18 **C. Notwithstanding the Federal Circuit's precedent that claim scope is limited by 19 written description and prosecution history, if the Court nevertheless construes 20 "plate" broadly to include manifold bodies made of compliant materials, then 21 the asserted claims should be found invalid for lack of written description**

22 If "plate" is construed broadly to include both rigid and non-rigid (compliant) materials, then 23 CoolIT cannot satisfy the written description requirement for its asserted claims. That is, if CoolIT 24 obtains a claim construction that includes manifold bodies made of compliant materials within the 25 scope of the claims, then the claims are invalid for lack of written description because CoolIT cannot 26 show that the inventor possessed the *full scope* of the claims at the time of the invention in August 27 2007. *See, e.g., Zoho Corp. v. Sentius Int'l, LLC*, 494 F. Supp. 3d 693, 704 (N.D. Cal. 2020) ("[T]he 28 scope of the written description must be commensurate with the scope of the claims.") (citing *Cisco Sys., Inc. v. Cirrex Sys., LLC*, 856 F.3d 997, 1007-08 (Fed. Cir. 2017); *see also Juno Therapeutics*,

1 *Inc. v. Kite Pharma, Inc.*, 10 F.4th 1330, 1336 (Fed. Cir. 2021) (requiring the asserted patent’s “written
 2 description [to] sufficiently demonstrate[] that the inventors possessed the full scope of the claimed
 3 invention”); *Rivera v. Int’l Trade Comm’n*, 857 F.3d 1315, 1319-21 (Fed. Cir. 2017) (affirming that
 4 “the specification did not provide the necessary written description support for the full breadth of the
 5 asserted claims,” where the claims were broadly directed to a “container . . . adapted to hold brewing
 6 material” while the specification disclosed only a “pod adapter assembly” or “receptacle” designed to
 7 hold a “pod”) (ellipsis in original).

8 In *Zoho*, the court expressly adopted patentee Sentius’ broad construction of the claim term
 9 “offset value” as “‘a value from a beginning point’—*any* beginning point—and rejected Zoho’s
 10 proposed construction based on ‘pure byte offsets.’” 494 F. Supp. 3d. at 708-09 (citation omitted;
 11 emphasis in original). As the court explained, “[t]his broad claim construction”—which patentee
 12 Sentius argued for and received—“now precludes Sentius from arguing that an offset necessarily
 13 involves determining a beginning address in an electronic database.” *Id.* Accordingly, the court found
 14 that the specification failed to provide written description for the disputed claim term and granted
 15 summary judgment of invalidity for lack of written description under 35 U.S.C. § 112. *Id.*

16 Similarly, in *Atlantic Research Marketing Systems, Inc. v. Troy*, patentee Atlantic Research
 17 advocated for and received—based on the alleged “plain meaning of claim language” and “substantive
 18 differences between claims”—a broad claim construction “that would cover a barrel nut-only design,
 19 perhaps to support its infringement arguments against the accused products (the accused products
 20 undisputedly attach to and receive support from only the barrel nut).” 659 F.3d 1345, 1355 (Fed. Cir.
 21 2011). Accordingly, the Federal Circuit had to “incorporate the barrel nut-only claim construction into
 22 the written description analysis.” *Id.* The Federal Circuit agreed with the district court that there was
 23 no written description support for the barrel-nut only design, even though the claims as construed
 24 “clearly cover[ed] such a design.” *Id.* As the Federal Circuit further explained, the claims “exceed[ed]
 25 in scope the subject matter that [the] inventor [] chose to disclose to the public in the written
 26 description” and thus held that the district court properly granted summary judgment invalidating the
 27 claims for failing to satisfy the written description requirement of 35 U.S.C. § 112. *Id.*

28 Here, just as in *Zoho* and *Atlantic Research*, CoolIT is advocating for a broad construction of

1 “plate” as covering manifold bodies made of either rigid or compliant materials in order to support its
 2 infringement arguments against Asetek’s Gen 5, 6, and 7 products (which undisputedly have a
 3 manifold body made of compliant material). But if CoolIT were to receive such a broad construction
 4 for “plate” that covers manifold bodies made of compliant materials, then the asserted claims should
 5 be found invalid under 35 U.S.C. § 112 for failing to satisfy the written description requirement. *Zoho*,
 6 494 F. Supp. 3d. at 708-09; *Atlantic Research*, 659 F.3d at 1355, *Juno Therapeutics*, 10 F.4th at 1336;
 7 *Rivera*, 857 F.3d at 1319-21.

8 Although it is correct that written description is a factual determination, here there are no
 9 genuine material disputes of fact regarding whether the relevant specifications disclose manifold
 10 bodies made of compliant materials. CoolIT’s expert’s reports fail to assert written description support
 11 for manifolds made of compliant materials in the 2007 Provisional. And the PTAB has already found
 12 that CoolIT’s expert’s written description arguments “are weak on several levels and fall far short of
 13 demonstrating to a POSITA that the inventor had possession of a manifold body defin[ing] a pair of
 14 compliant surfaces in 2007.” Ex. C at 27.

15 The PTAB’s written description finding is significant here because CoolIT is issue-precluded
 16 from relitigating written description support for compliant manifold bodies in the district court as this
 17 exact written description issue was previously adjudicated in the IPR proceeding between the same
 18 parties. *Beauchamp v. Anaheim Union High Sch. Dist.*, 816 F.3d 1216, 1225 (9th Cir. 2016).
 19 Specifically, in the Ninth Circuit, issue preclusion requires that (1) the issue must be identical to the
 20 one alleged in prior litigation; (2) the issue must have been “actually litigated” in the prior litigation;
 21 and (3) the determination of the issue in the prior litigation must have been “critical and necessary” to
 22 the judgment. *Id.* (quoting *Clark v. Bear Stearns & Co., Inc.*, 966 F.2d 1318, 1320 (9th Cir. 1992)).
 23 Here, all three factors for issue preclusion are met. First, the issue of whether there is written
 24 description for compliant manifold bodies is the identical issue that was litigated in the PTAB.⁴
 25 Second, this issue was “actually litigated,” and in fact, it was the only issue relating to patentability of
 26

27 ⁴ At the PTAB, CoolIT’s only argument for patentability was that the challenged claims 1, 2, 5, and 9
 28 of the ’266 patent are entitled to the 2007 priority date because the 2007 Provisional allegedly shows
 that “the inventor had possession of a manifold body made of compliant material, namely plate 240.”
 Ex. C at 22-23. The PTAB rejected that argument and found there was no written description support
 for manifold body made of compliant material. *Id.* at 23-24.

1 challenged claims 1, 2, 4, 5, and 9 of the '266 patent that was litigated between the parties in the
 2 PTAB. *See generally* Ex. C at 21-32. Third, the determination of lack of written description was critical
 3 and necessary to the PTAB's final decision that the claims 1, 2, 4, 5, and 9 of the '266 patent are
 4 unpatentable. *Id.* at 30.

5 CoolIT has thus had a full and fair opportunity to litigate the issue of written description
 6 support in the 2007 Provisional in the IPR proceeding at the PTAB. Moreover, it declined to appeal
 7 the PTAB's decision to the Federal Circuit, thus rendering the PTAB's decision a final judgment on
 8 this issue. Bhattacharyya Decl., ¶22. The PTAB decision therefore precludes CoolIT from continuing
 9 to litigate this same issue in this Court. Indeed, the Federal Circuit has repeatedly found that a final
 10 judgment from the PTAB has an issue-preclusive effect on any pending district court action involving
 11 the same issue. *XY, LLC v. Trans Ova Genetics, L.C.*, 890 F.3d 1282, 1294 (Fed. Cir. 2018) (a final
 12 judgment from the PTAB "has an immediate issue-preclusive effect on any pending or co-pending
 13 actions involving the patent" because "a patentee, *having been afforded the opportunity to exhaust his
 14 remedy of appeal from a holding of invalidity*, has had his day in court[.]") (emphasis added) (citation
 15 and quotation marks omitted); *see also Fresenius USA, Inc. v. Baxter Int'l, Inc.*, 721 F.3d 1330, 1344
 16 (Fed. Cir. 2013) ("[T]here is no basis for distinguishing between the effects of a final, affirmed court
 17 decision determining invalidity and a final, affirmed PTO decision determining invalidity on a pending
 18 litigation."); *MaxLinear, Inc. v. CF CRESPE LLC*, 880 F.3d 1373, 1376 (Fed. Cir. 2018) ("[It is] clear
 19 that issue preclusion is not limited to those situations in which the same issue is before two courts.
 20 Rather, where a single issue is before a court and an administrative agency, preclusion also often
 21 applies.") (alteration in original) (emphasis omitted) (quoting *B&B Hardware, Inc. v. Hargis Indus.*,
 22 575 U.S. 138, 148, (2015)). The preclusive effect of a final PTAB judgment applies even though the
 23 district court and PTAB have different burdens of proof. *See XY*, 890 F.3d at 1294. Moreover, this
 24 Court can apply collateral estoppel *sua sponte* to avoid "unnecessary judicial waste[.]" *Id.* at 1295
 25 (citing and quoting *Arizona v. California*, 530 U.S. 392, 412 (2000)).

26 **D. Conclusion**

27 "Plate" should be construed as a "flat manifold body made of rigid material." Specifically,
 28 "plate" should not be construed broadly to include manifolds made of compliant materials, because

1 there is no written description support for that, as the PTAB has already found in a final judgment.
 2 When “plate” is construed correctly to not include compliant manifolds, there is no genuine dispute
 3 that Asetek’s accused Gen 5, 6, and 7 products do not include the claimed “plate,” rather they each
 4 have a compliant gasket manifold, and therefore they do not infringe the asserted claims, and summary
 5 judgment should be granted accordingly. If, however, “plate” is construed broadly to include manifold
 6 bodies made of compliant material (as in Asetek’s accused Gen 5, 6, and 7 products), then the claims
 7 are invalid for lack of written description under Section 112, ¶1 and CoolIT is issue-precluded from
 8 arguing otherwise in this case, and the Court should grant summary judgment accordingly.

9 **V. THE COURT SHOULD GRANT SUMMARY JUDGMENT OF NO INVALIDITY OF**
 10 **CLAIMS 17 AND 19 OF THE ’362 PATENT UNDER OBVIOUSNESS GROUNDS 4-9**
 11 **BECAUSE COOLIT CANNOT MEET ITS BURDEN TO PROVE MOTIVATION TO**
COMBINE THE PRIOR ART REFERENCES AND REASONABLE EXPECTATION
OF SUCCESS IN DOING SO

12 It is well-settled that a party alleging obviousness must establish, *inter alia*, a motivation to
 13 combine the asserted prior art references and a reasonable expectation of success for doing so. *See*,
 14 e.g., *Microsoft Corp. v. Enfish, LLC*, 662 F. Appx 981, 990 (Fed. Cir. 2016) (affirming finding of non-
 15 obviousness because patent challenger “did not articulate a sufficient motivation to combine,” even
 16 though the prior art references “arguably disclose[d] every limitation” of the challenged claims); *In re*
 17 *Warsaw Orthopedic, Inc.*, 832 F.3d 1327, 1333 (Fed. Cir. 2016) (“As part of the obviousness inquiry,
 18 we consider whether a PHOSITA would have been motivated to combine the prior art to achieve the
 19 claimed invention and whether there would have been a reasonable expectation of success in doing
 20 so.”) (internal quotation marks, brackets and citation omitted); *Impax Labs., Inc. v. Lannett Holdings*
 21 *Inc.*, 893 F.3d 1372, 1380-81 (Fed. Cir. 2018) (affirming the district court’s finding of non-
 22 obviousness because a skilled artisan would not have been motivated to make the claimed invention
 23 with a reasonable expectation of success); *In re NuVasive, Inc.*, 842 F.3d 1376, 1381-82 (Fed. Cir.
 24 2016) (same). Here, Dr. Abraham failed to opine on a motivation and a reasonable expectation of
 25 success for combining Ryu with Wu or Batchelder in Grounds 4 and 5; Batchelder with Shin, Ryu, or
 26 Wu in Grounds 6-8; and Yu in view of Wu in Ground 9. The following are at least some of deficits in
 27 each of Grounds 4-9, which establish that Dr. Abraham’s obviousness analyses in Grounds 4-9 are
 28 deficient as a matter of law:

1 **Grounds 4 and 5 (Ryu in view of Wu or Batchelder):** Dr. Abraham admits that Ryu does not
 2 disclose the claimed “reservoir” having dual chambers, as required by independent claim 17 of the
 3 ’362 patent, but argues that Wu and/or Batchelder discloses such a “reservoir.” Ex. AA at ¶¶169, 186.
 4 But even if Wu or Batchelder discloses such a “reservoir” (which Asetek disputes), Dr. Abraham did
 5 not explain how or why Ryu would have been combined with Wu or Batchelder to arrive at the
 6 “reservoir” element of claim 17. *See id.* at ¶169 (simply asserting that “[a] POSA would have been
 7 motivated to modify Ryu in view of Wu to combine Ryu’s pump driving unit and water jacket into a
 8 ‘single receptacle defining a fluid flow path’” without any further explanation); *id* at ¶186 (same with
 9 respect to Batchelder). Dr. Abraham’s conclusory assertion that Wu or Batchelder discloses the
 10 claimed “reservoir,” without further explanation of how Ryu would have been combined with Wu or
 11 Batchelder, or why one skilled in the art would have been motivated to do so, is insufficient to render
 12 claims 17 and 19 obvious. *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1379 (Fed. Cir. 2016)
 13 (reversing obviousness finding because, *inter alia*, the patent challenger “failed to provide any analysis
 14 of how or why the asserted prior art could be combined) (emphasis added); *PersonalWeb Techs., LLC*
 15 v. *Apple, Inc.*, 848 F.3d 987, 994 (Fed Cir. 2017) (reversing because, *inter alia*, “the Board nowhere
 16 clearly explained, or cited evidence showing, how the combination of the two references was supposed
 17 to work.”) (emphasis added); *TriVascular, Inc. v. Samuels*, 812 F.3d 1056, 1066 (Fed. Cir. 2016)
 18 (requiring explanation of how or why references would be combined to produce the claimed invention).

19 **Grounds 6, 7, and 8 (Batchelder in view of Shin, Ryu, or Wu):** With respect to Grounds 6-8, Dr.
 20 Abraham simply asserts that the “combination of Batchelder and Shin,” the “combination of
 21 Batchelder and Ryu,” and the “combination of Batchelder and Wu” disclose the limitations of claims
 22 17 and 19. *See generally* Ex. AA at ¶¶208-238. Dr. Abraham has not provided a single sentence
 23 explaining how or why Batchelder would have been combined with Shin, Ryu, or Wu to arrive at
 24 Asetek’s claimed invention, without which CoolIT’s obviousness combination in Grounds 6-8 fail. *In*
 25 *re Magnum Oil*, 829 F.3d at 1379; *PersonalWeb*, 848 F.3d at 994.

26 **Ground 9 (Yu in view of Wu):** Dr. Abraham asserts in his Invalidity Report that he has “explained”
 27 how Yu in view of Wu renders claims 17 and 19 of the ’362 patent obvious. Ex. AA at ¶¶239-248.
 28 But there is no such explanation in his Report. Nor has he explained how or why a person skilled in

1 the art would have combined Yu and Wu to arrive at the invention claimed in the '362 patent. Ground
 2 9 fails to show obviousness of claims 17 and 19 of the '362 patent for that reason alone. *In re Magnum*
 3 *Oil*, 829 F.3d at 1379; *PersonalWeb*, 848 F.3d at 994.

4 Ultimately, Dr. Abraham's motivation to combine allegations distil down to: "because [the
 5 asserted prior art references] are attempting to solve similar issues and each disclose or teach known
 6 techniques that can be used for one another, a POSA, when reading all of these references together,
 7 would have been motivated to combine [the references]." *See* Ex. AA at ¶¶693-771. But such a
 8 conclusory assertion that the prior art references fall within the same alleged field, without an
 9 explanation of how a skilled artisan would have combined them and how the proposed combination
 10 would have worked, is not a legally sufficient motivation for combining any of the prior art references.
 11 *ActiveVideo Networks, Inc. v. Verizon Communs., Inc.*, 694 F.3d 1312, 1327 (Fed. Cir. 2012) (finding
 12 obviousness analysis "not sufficient and fraught with hindsight bias" when it "failed to explain how
 13 specific references could be combined . . . or how any specific combination would operate or read on
 14 the asserted claims") (citing *KSR*, 550 U.S. at 418 ("A patent composed of several elements is not
 15 proved obvious by merely demonstrating that each of its elements was, independently, known in the
 16 prior art.")); *Securus Techs., Inc. v. Glob. Tel*Link Corp.*, 701 F. Appx. 971, 977 (Fed. Cir. 2017)
 17 (finding the "broad characterization" of the references as falling within the same alleged field, without
 18 an explanation of "how or why" they would be combined, was insufficient to support obviousness);
 19 *see also Asia Vital Components Co. v. Asetek Danmark A/S*, 377 F. Supp. 3d 990, 1013 (N.D. Cal.
 20 2019) ("Ultimately, '[w]ithout any explanation as to how or why the references would be combined
 21 to arrive at the claimed invention,' the Court is 'left with only hindsight bias that *KSR* warns against.'")
 22 (quoting *Metalcraft of Mayville, Inc. v. The Toro Co.*, 848 F.3d 1358, 1367 (Fed. Cir. 2017)).

23 At bottom, Dr. Abraham's alleged motivations to combine in Grounds 4-9 are conclusory and
 24 legally deficient. He alleges that certain claim elements disparately existed in the prior art and that a
 25 skilled artisan would have combined them. But such conclusory assertions of motivation are not
 26 sufficient to support a finding of obviousness. *TQ Delta, LLC v. Cisco Sys., Inc.*, 942 F.3d 1352, 1358-
 27 59 (Fed. Cir. 2019) ("[A] conclusory assertion with no explanation is inadequate to support a finding
 28 that there would have been a motivation to combine"); *Nuvasive*, 842 F.3d at 1383. Rather, a legally

1 sufficient motivation to combine analysis requires an explanation of why a skilled artisan would pick
 2 out particular references and combine them in the manner claimed, which Dr. Abraham failed to do.
 3 *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (requiring a showing that a skilled artisan “would
 4 select the elements from the cited prior art references for combination in the manner claimed.”);
 5 *Personal Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 993-94 (Fed. Cir. 2017) (requiring “a
 6 motivation to pick out [the asserted] references and combine them to arrive at the claimed invention.”);
 7 *Innogenetics, N.V. v. Abbott Labs.*, 512 F.3d 1363, 1373 (Fed. Cir. 2008) (same). Dr. Abraham’s
 8 motivation to combine allegations in Grounds 4-9 are therefore deficient as a matter of law.

9 Even if the Court were to find a motivation to combine the references in Grounds 4-9 (it should
 10 not for the reasons explained above), Dr. Abraham’s obviousness allegations in Grounds 4-9 still fail
 11 as a matter of law because he failed to show that a person skilled in the art would have had a reasonable
 12 expectation of success in combining the asserted references. *Amgen, Inc. v. F. Hoffman-La Roche,
 13 Ltd.*, 580 F.3d 1340, 1362 (Fed. Cir. 2009). (“An obviousness determination requires that a skilled
 14 artisan would have perceived a reasonable expectation of success in making the invention in light of
 15 the prior art.”). Dr. Abraham simply contends that “a POSA, when reading all of these references
 16 together, would have been motivated to combine [the references].” *See* Ex. AA at ¶¶693-771. But that
 17 is insufficient to establish that a person skilled in the art would have reasonably expected success in
 18 such combination. *See In re Stepan Co.*, 868 F.3d 1342, 1347 (Fed. Cir. 2017). Rather, “a finding of
 19 obviousness at the time of invention requires a ‘plausible rational[e] as to why the prior art references
 20 would have worked together.’” *Broadcom Corp. v. Emulex Corp.*, 732 F.3d 1325, 1335 (Fed. Cir.
 21 2013) (quoting *Power-One, Inc. v. Artesyn Techs., Inc.*, 599 F.3d 1343, 1351 (Fed. Cir. 2010)).

22 Given that fact and expert discovery have closed, and CoolIT failed to present legally sufficient
 23 evidence on the motivation to combine and reasonable expectation of success elements of obviousness
 24 for Grounds 4-9, CoolIT cannot meet its burden to prove obviousness of the challenged claims under
 25 Grounds 4-9. *Mytee*, 439 Fed. Appx. at 886. Summary judgment of no invalidity of claims 17 and 19
 26 of the ’362 patent is therefore appropriate. *Id.*; *see also Asia Vital Components*, 377 F. Supp. 3d at
 27 1014 (granting summary judgment of no obviousness because AVC failed to present evidence from
 28 which a jury could reasonably find motivation to combine and reasonable expectation of success).

1 Dated: March 31, 2022

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